PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Karl J. Wood et al.
For	:	BROADCAST ENHANCEMENT SYSTEM AND METHOD
Serial No.:	:	09/747,109
Filed	:	December 21, 2000
Art Unit	:	2617
Examiner	:	J. G. Ustaris
Att. Docket	:	PHB 34,436
Confirmation No.	:	1480

APPEAL BRIEF

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed August 30, 2006.

I. REAL PARTY IN INTEREST

The party in interest is U.S. PHILIPS CORPORATION, by way of an Assignment recorded at Reel 011406, Frame 0884.

II. RELATED APPEALS AND INTERFERENCES

Following are identified any prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal:

NONE.

III. STATUS OF CLAIMS

Claims 1-6, 9, 15, 17 and 20-25 are pending.

Claims 1-6, 9, 15, 17 and 20-25 are rejected.

Claims 7, 8, 10-14, 16, 18 and 19 are canceled.

No claims are allowed.

Claims 1-6, 9, 15, 17 and 20-25 are on appeal.

IV. STATUS OF AMENDMENTS

All amendments filed in this application have been entered. No Amendment was filed After Final Rejection. An Amendment under 37 C.F.R. § 1.111 was filed on April 24, 2006, and was entered into the record.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The subject matter recited in claims 1-6, 9, 15, 17 and 20-25 relates to a broadcast enhancement system and method, and a mixer for use in said broadcast enhancement system.

Independent claim 1 recites a broadcast enhancement system compatible with a television and with a set-top-box having a receiver for receiving a television broadcast signal (see Fig. 1 and page 4, lines 7-12 of the specification). No adaptation is required to the set-top-box or the television (page 5, lines 4-6). The system comprises a mixer having another receiver for receiving a transmission of an enhancement signal. The two receivers are arranged separately from each other (Fig. 1 and page 4, lines 11-13). The mixer is configured to intercept the received television broadcast signal from the set-top-box before it is passed to the television, to apply chroma keying to superimpose the enhancement signal onto the intercepted television broadcast signal, and to pass the superimposed signal to the television (page 4, lines 13-18).

Independent claim 9 recites a method of enhancing a television broadcast as performed by the system recited in claim 1.

Independent claims 15 and 17 recite a mixer for use in a broadcast enhancement system as recited in claim 1 and adapted for enhancing a television image using the method recited in claim 9.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

A. Claims 1-6, 9, 15, 17 and 20-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Butler et al. (US 2002/0007493), hereinafter "Butler," in view of Perlman (US 6,829,779), hereinafter "Perlman."

VII. ARGUMENT

A. Rejection of Claims 1-6, 9, 15, 17 and 20-25 under 35 U.S.C. § 103(a)

The Final Office Action dated June 13, 2006, rejects claims 1-6, 9, 15, 17 and 20-25 under 35 U.S.C. § 103(a) as being unpatentable over Butler in view of Perlman.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). *See* MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

1. Claims 1, 9, 15 and 17

Butler does not disclose, teach or suggest "**a set-top-box that has a receiver** for receiving a television broadcast signal" and "**a mixer having a receiver** for receiving a transmission of an

enhancement signal, **the two receivers being arranged separately from each other**" as recited in claims 1 and 15 (emphasis added).

Instead, Butler discloses a plurality of PCs (*See*, e.g., Fig. 1) each PC including only one receiver (ref. 58 on Fig. 2) for receiving a video stream and supplemental data files from a broadcast source. Both the broadcast video stream and the accompanying supplemental files disclosed in Butler are sent by one broadcast source and received by one receiver in each PC (Abstract, Figs. 4-5 and § 0052-0054).

Furthermore, as correctly conceded by the Office Action, Butler does not disclose, teach or suggest "a set-top-box that has a receiver for receiving a television broadcast signal," and a mixer that is "configured to intercept the received television broadcast signal from the set-top-box before it is passed to the television" as recited in claims 1, 9, 15 and 17. Thus, the Office Action relies upon a second reference, Perlman, for this subject matter. However, Appellant respectfully submits that Perlman fails to overcome the deficiencies in Butler.

Instead, Perlman discloses a connecting configuration wherein a video signal coming out of a cable box is fed into the input port of a VCR. The output from the VCR is then fed into an Internet terminal (via a coaxial cable) and, in parallel, directly into a TV set (via an A/V cable). Both the VCR and the Internet terminal outputs are thus fed in parallel into the TV set. Perlman does not disclose, teach or suggest a mixer "**configured to intercept** the received television broadcast signal **from the set-top-box** before it is passed to the television" as recited in claims 1, 9, 15 and 17 (emphasis added)

Additionally, the Office Action does not provide any suggestion or motivation **in the references themselves** to modify and/or combine said references. *See* Office Action, page 3, lines 12-18. Rather, the Office Action attempts to substitute facts within the personal knowledge of the Examiner for a motivation or suggestion to combine within the references themselves.

Applicant respectfully submits that the Office Action's reliance on facts within the personal knowledge of the Examiner is improperly taken. According to 37 C.F.R. § 1.104(d)(2), discussed and cited in M.P.E.P. § 2144.03, the Examiner is required to submit an affidavit supporting the facts of which the Examiner relies upon, subject to contradiction or explanation by the Applicant and other persons. The Examiner did not provide such an affidavit.

Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *See In re Mills*, 916 F.2d 680, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (holding that, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so"); *see also In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Similarly, even if the references relied upon establish that all aspects of the claimed invention were individually known in the art at the time the claimed invention was made, a statement by the Examiner that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *See Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Here, there is no suggestion or motivation, either in the two applied references themselves or in the knowledge generally available to one of ordinary skill in the art at the time the application was filed, to modify or to combine the two applied references by picking, choosing and combining various parts of these two references, to the exclusion of other parts of the references. Doing so requires a significantly precise motivation that is not found in any of the cited references. Rather the only motivation to arrive at the claimed combination by picking and choosing the various parts of the applied references to the exclusion of the other parts of those references is found in the Applicant's disclosure itself.

For at least the foregoing reasons, Appellant respectfully submits that claims 1, 9, 15 and 17 are patentable over Butler in view of Perlman because the combination of Butler and Perlman does not disclose, teach or suggest each and every element recited in claims 1, 9, 15 and 17, and because there is no suggestion or motivation, either in the two applied references themselves or in the knowledge generally available to one of ordinary skill in the art at the time the application was filed, to modify or to combine these two references.

2. Claims 2-6

Claims 2-6 depend from claim 1 and are therefore also patentable for at least the reasons stated above in connection with claim 1, as well as for the separately patentable subject matter recited therein.

2. Claims 20-21

Claims 20-21 depend from claim 17 and are therefore also patentable for at least the reasons stated above in connection with claim 17, as well as for the separately patentable subject matter recited therein.

2. Claims 22-23

Claims 22-23 depend from claim 9 and are therefore also patentable for at least the reasons stated above in connection with claim 9, as well as for the separately patentable subject matter recited therein.

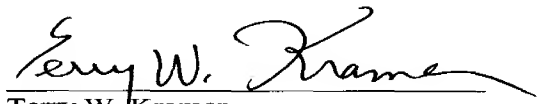
2. Claims 24-25

Claims 24-25 depend from claim 15 and are therefore also patentable for at least the reasons stated above in connection with claim 15, as well as for the separately patentable subject matter recited therein.

CONCLUSION

For at least the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-6, 9, 15, 17 and 20-25 are in condition for allowance. For at least the above reasons, Appellants respectfully request that this Honorable Board reverse the rejections of claims 1-6, 9, 15, 17 and 20-25.

Respectfully submitted,
KRAMER & AMADO, P.C.



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VIII. CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. A broadcast enhancement system compatible with a television and a set-top-box that has a receiver for receiving a television broadcast signal, without any adaptation required to the set-top-box or the television, said system comprising a mixer having a receiver for receiving a transmission of an enhancement signal, the two receivers being arranged separately from each other, at least one of the two signals being prepared for chroma keying, the mixer being configured to intercept the received television broadcast signal from the set-top-box before it is passed to the television, to apply chroma keying to superimpose the enhancement signal onto the intercepted television broadcast signal and to pass the superimposed signal to the television.

2. A system according to claim 1, including a processor for formatting data received in the enhancement signal prior to applying chroma keying to superimpose it onto the television broadcast signal.

3. A system according to claim 1, in which the enhancement signal comprises a World Wide Web page.

4. A system according to claim 1 in which the enhancement signal is multiplexed with the television broadcast signal prior to transmission, wherein the system includes a demultiplexer for extracting the enhancement signal from the received television broadcast signal.

5. A system according to claim 1, in which the enhancement signal is received as teletext.

6. A system according to claim 1, in which the enhancement signal is received via the internet.

9. A method of enhancing a television broadcast comprising the steps of:

preparing a plurality of broadcast signals, at least one of which being prepared for chroma keying;

transmitting the plurality of broadcast signals to a corresponding receiver, at least one of the corresponding receivers being in a set-top-box;

providing said received signals to a mixing unit that is separate from the set-top-box;

applying, in the mixing unit, chroma keying to the received signals to create a superimposed signal for display as an enhanced television broadcast.

15. A mixer for use in a broadcast enhancement system that is compatible with a television and set-top-box that has a receiver for receiving a television broadcast signal, without any adaptation required to the set-top-box or the television, said mixer being connected to a receiver for receiving an enhancement signal, the two receivers being arranged separately from each other, at least one of the

two signals being prepared for chroma keying, the mixer further configured to intercept the received television broadcast signal from the set-top-box before it is passed to the television, to apply chroma keying to superimpose the enhancement signal onto the intercepted television broadcast signal and to pass the superimposed signal to the television.

17. A mixer for enhancing a television image comprising:

means for receiving a broadcast television signal; and

means for receiving an enhancement signal, at least one of the two signals being prepared for chroma keying, wherein said mixer is configured to apply chroma keying to superimpose the enhancement signal onto the received television broadcast signal and to pass the superimposed signal to a television set, wherein the broadcast television signal is input to said mixer from a set-top box.

20. The mixer of claim 17, wherein the enhancement signal is received via the Internet.

21. The mixer according to claim 17, wherein the enhancement signal is received via a wireless transmission.

22. The method of enhancing a television broadcast of claim 9, wherein one of the plurality of broadcast signals is received via the Internet.

23. The method of enhancing a television broadcast of claim 9, wherein one of the plurality of broadcast signals is received via a wireless transmission.

24. The mixer of claim 15, wherein one of the two signals is received via the Internet.

25. The mixer of claim 15, wherein one of the two signals is received via a wireless transmission.

IX. EVIDENCE APPENDIX

Listing and copies of evidence relied upon by the Examiner as to grounds of rejection to be reviewed on Appeal:

1. US Patent Application Publication No. 2002/0007493 to Butler et al. was relied upon by the Examiner as a primary reference for § 103(a) rejections in the Final Office Action dated 06/13/2006.

2. US Patent No. 6,829,779 to Perlman was relied upon by the Examiner as a secondary reference for § 103(a) rejections in the Final Office Action dated 06/13/2006.

X. RELATED PROCEEDINGS APPENDIX

NONE